

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Philip M. Ginsberg, et al.
Application No. : 09/853,430 Confirmation No. : 6761
Filed : May 10, 2001
For : SYSTEMS AND METHODS FOR ANONYMOUS
ELECTRONIC TRADING
Group Art Unit : 3691
Examiner : Olabode Akintola

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Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request review of the Final Rejection mailed December 31, 2007 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

REMARKS

For the following reasons, Applicants request review of the Final Rejection mailed December 31, 2007 in the present application.

I. The OFFICE ACTION IS PROCEDURALLY INADEQUATE TO RAISE ANY REJECTION OF CLAIMS 4-8, 17-21, 38-39, and 44-46 AND FAILS TO ESTABLISH A PRIMA FACIE CASE OF ANTICIPATION OF THESE CLAIMS

At pages 3-6 of the Office Action, claims **4-8, 17-21, 38-39, and 44-46** are rejected under 35 U.S.C. § 102(b) as being anticipated by Togher et al., U.S. Patent 6,014,627 (hereinafter Togher). Independent claim **4** is representative of the claims and recites:

A method comprising:

causing to be presented to at least a respective first trader and second trader an interface comprising a plurality of options on how the respective trader wants a trading system to process pending trades that cause warning limits to be exceeded, the plurality of options including:

*the trading system automatically rejecting the pending trades,
the trading system automatically executing in part the pending trades such that the executed in part trades do not cause the warning limits to be exceeded, and
the trading system automatically executing in full the pending trades;*

receiving from each of the first trader and the second trader a selection of one of the plurality of options;

in addition to the selection of the first trader, receiving from the first trader a first warning limit specified against the second trader;

in addition to the selection of the second trader, receiving from the second trader a second warning limit specified against the first trader;

after receiving the selection of the first trader, the selection of the second trader, the first warning limit, and the second warning limit:

*receiving at the trading system a first order from the first trader; and
receiving at the trading system a second order from the second trader,
in which the first order and the second order result in a pending trade between the first trader and the second trader;*

determining that execution of the pending trade between the first trader and the second trader causes at least one of the first warning limit and the second warning limit to be exceeded; and

processing the pending trade between the first trader and the second trader based on the selection of the first trader and the selection of the second trader, in which processing the pending trade comprises at least one of:

the trading system automatically rejecting the pending trade,
the trading system automatically executing in part the pending trade such that the executed in part trade does not cause the first warning limit nor the second warning limit to be exceeded, and
the trading system automatically executing in full the pending trade.

(**bold** emphasis added).

The Office Action fails to designate or explain any correspondence between Togher and at least the bolded limitations of claim 4. Accordingly, the Office Action (1) is procedurally inadequate to raise any rejection of claim 4 and, (2) fails to establish a *prima facie* case of anticipation of claim 4. Furthermore, because of the inadequacy of the Office Action, Applicants are unable to respond to any apparent rejection of claim 4 (and similarly any other claim) because Applicants cannot discern how the Examiner deems Togher to disclose at least the bolded limitations.

37 C.F.R. § 1.104(c)(2) sets the minimum standards for any validly-issued Office Action:

§ 1.104 Nature of examination.

(c) Rejection of claims.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

In other words, in situations where a reference discloses anything more than the invention claimed, as here, Rule 1.104 requires the Office Action: (i) to “designate” the particular part of the reference relied on and, (ii) to “clearly explain[]” the pertinence of the reference when not apparent.

Failing to designate any particular part of Togher that discloses the bolded limitations of claim **4** and failing to provide any explanation as to how Togher may disclose such limitations clearly violates both requirements of 37 C.F.R. § 1.104(c)(2). Accordingly, the Office Action is procedurally inadequate to raise any rejection of claim **4** (and similarly, claims **5-8, 17-21, 38-39, and 44-46**).

MPEP § 2131 elaborates on an Office Action's duties under § 102:

**2131 Anticipation — Application of 35 U.S.C. 102(a), (b), and (e)
TO ANTICIPATE A CLAIM, THE REFERENCE MUST
TEACH EVERY ELEMENT OF THE CLAIM**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ... claim.

MPEP § 2131 (internal quotes emitted) (emphasis added).

It is the Examiner's burden to make all required showings. In re Warner, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967) (The patent statute "clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103. ... Where such proof is lacking there is no necessity for resolving doubt in favor of the Patent Office's position."). It is not Applicants duty to guess at the Examiner's position. See Ex parte Schricker, 56 USPQ2d 1723, 1725 (Bd. Pat. App. & Interf. 2000) (applicants are not required to "guess as to the basis of the rejection" or to "further guess... what part of [the references] supports the rejection").

Because the Office Action fails to show that Togher discloses "each and every element" of claim **4**, the Office Action fails to establish a *prima facie* case of anticipation of this claim (and similarly, claims **5-8, 17-21, 38-39, and 44-46**).

II. CONCLUSION

Because the Office Action (1) is procedurally inadequate to raise any rejection of claims **4-8, 17-21, 38-39, and 44-46** and, (2) fails to establish a *prima facie* case of anticipation of these claims, withdrawal of the rejections is respectfully requested.

Respectfully submitted,

/Glen R. Farbanish/

March 20, 2008

Date

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